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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,216	01/02/2004	Philip S. Siegel	067439.0157	1168
5073 7590 05/16/2008				
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				
EXAMINER				
SHAAWAT, MUSSA A				
ART UNIT		PAPER NUMBER		
3627				
NOTIFICATION DATE		DELIVERY MODE		
05/16/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com  
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### Office Action Summary

**Application No.**

10/751,216

**Applicant(s)**

SIEGEL, PHILIP S.

**Examiner**

MUSSA A. SHAAWAT

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 8 and 10-32 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8, 10-16 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 2/22/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This action is in response to communications filed on 09/07/2007. Claims 1, and 32 have been amended. Claims 1-5, 7-8, 10-16 and 29-32 are pending examination.
2. IDS submitted on 02/22/2008 have been considered.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of

activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-8, 10-16 and 29-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 35-46 of copending Application No. 09/817,353 referred to hereinafter as '353. Although the conflicting claims are not identical, they are not patentably distinct from each other. '353 teaches all the limitations of claims 1-5, 7-8, 10-16 and 29-32 of the present application except for generating data for printing a return label for a particular merchandise. '353 teaches initiating a return process in response to receiving the electronic selection which may include generating data for printing a return label, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit generating data for printing a return label from '353.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 7-8, 13, 15 and 30-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Arganbright et al., US Patent No. (6,980,962) referred to hereinafter as Arganbright in view of Cybul et al., US Patent No. (6246997) referred to hereinafter as Cybul.

Claim 1: Arganbright discloses a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction, (see at least col.62. line 65-col.63 line 10);

In response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, (see col. 63 lines 8-11);

In response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer, (see col. 63 lines 29-35)

Arganbright does not expressly teach displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction. However Cybul teaches displaying to the customer via the web access tool, the

transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction (see at least Abstract, and col.2 lines 25-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in order to provide the consumer with the convenience of viewing his purchase history online.

In addition Neither Arganbright nor Cybul expressly teach receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic transaction selection comprising a click on the particular item of merchandise in the list displayed to the customer. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Arganbright in view of Cybul to include an electronic selection from a displayed list of items to the consumer via a web access tool in order to provide the consumer with a user friendly user interface and the convenience of performing on line shopping or e-commerce which include purchasing or returning merchandise.

Claim 2: Arganbright teaches wherein the displaying step is performed by displaying a return information web page (see col.63 lines 5-10).

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Claim 7/8: Arganbright teaches a method comprising the step of accessing a database to obtain merchant return rules, and displaying at least one of the merchant return rules, (see col.63 1-10).

Claim 13: Arganbright teaches the step of notifying a merchant of the return item, (see col. 63 lines 18-22).

Claim 15: Arganbright disclose downloading the data for printing a return label to the web access tool, (see col.63 lines 30-35).

Claim 30: Arganbright teaches updating a customer profile associated with customer (see col.65 lines 7-10).

Claim 31: Arganbright teaches a method of claim 1, further comprising sending a notification to a merchant associated with a particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise (se col.63 lines 18-22).

Claim 32: the limitations of claim 32 are similar to the limitations of claims 1, and 30-31, therefore claim 32 is rejected based on the same rationale.

6. Claims 3-5 and 10-12, 14, 16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Cybul et al., in further view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

RE: Claim 5, Arganbright nor Cybul do not expressly teach accessing a database to obtain customer information about the customer, and wherein the displaying step includes displaying at least part of the customer information. However Roman teaches as evident by Roman accessing a database to obtain customer information about the customer (see pp 0016 line 3), and wherein the displaying step includes displaying at least part of the customer information (Roman disclose the offered replacement product and is read as part of customer information since it will reference the initial product). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to make it convenient for the user or customer to be able to retrieve and view their information.

Re claim 10: Arganbright nor Cybul do not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Re claim 11: Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517.

Claim 12: Arganbright nor Cybul do not expressly teach the step of performing the return is valid is performed by accessing one or more return rules associated with the merchant. However Roman teaches an e-tailer establishes parameter e.g. rules to determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright the motivation being the same as in claim 10.

Claims: 14/16: Arganbright nor Cybul do not expressly teach the step of notifying a merchant of information about the customer, and the step of delivering data about the return to a customer account record. However Roman et al discloses a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged, by the processing center pp0022 line 8).

Claims 3, and 4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is hereby made final.

Claim 29: although Arganbright in view of Roman in further view of Cybul teach a customer returning/exchanging a product and accessing a database to obtain customer

information such as name, receipt number, phone number and product description (see Roman et al). Neither Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information.

Examiner takes Official Notice that accessing a database to obtain customer information comprising credit card information or shipping information of a customer is well know and old in the art. It would have been obvious to modify the disclosure of Arganbright and Roman et al, to include accessing a database to obtain customer information comprising credit card information or shipping information of a customer, in order to credit the appropriate amount to the customer account or to ship back a defective product for example.

### ***Response to Arguments***

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Examine note: The official notice statement recited in the previous office action dated 11/29/2007, *is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.* See, MPEP 2144.02.

### ***Cited references***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

***Contact information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/  
Examiner, Art Unit 3627  
April 18, 2008

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627